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REMARKS

The indication of allowable subject matter in claims 9, 11, 15 and 16 is acknowledged and appreciated. In view of the following remarks, it is respectfully submitted that all claims are in condition for allowance.

Claim 1 stands rejected under 35 U.S.C. § 101 because it allegedly does not produce a tangible result. This rejection is respectfully traversed for the following reasons. The Examiner merely concludes that claim 1 does not provide a tangible result, without providing any explanation or reasoning as to the basis for his position. Indeed, contrary to the Examiner's position, claim 1 is directed to a "method for developing a program which is to be installed in a system having an LSI device" and expressly recites in pertinent part "***developing the program*** on the development LSI device." Accordingly, it is respectfully submitted that claim 1 has a tangible result for at least the reason that the method results in a program being developed. Based on the foregoing, it is respectfully requested that this rejection be withdrawn.

Claims 7 stands rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Examiner alleges that the "administrator mode" is not described in Applicants' specification. However, it is respectfully submitted that Applicants' specification provides plenty of support for the claimed "administrator mode." The Examiner is directed to, for example, page 10, lines 21+; page 13, lines 8+; etc., for exemplary descriptions of an "administrator mode." Based on the foregoing, it is respectfully requested that this rejection be withdrawn.

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Claims 1 and 8 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. It is respectfully submitted that the enclosed amendment obviates the Examiner's alleged indefiniteness regarding the reference to an LSI device having the same structure as that of the LSI device. Namely, as made clear by the enclosed amendment, a program can be developed using another LSI device different from the LSI device of the system in which the program is installed.

Regarding the Examiner's allegation that the features "storing a raw (binary) program" and "encrypting the raw (binary) program" of claim 8 are not adequately described, the Examiner is directed to page 18, lines 1-18, etc., of Applicants' specification for exemplary descriptions of "storing a raw (binary) program" and "encrypting the raw (binary) program."

Regarding the Examiner's allegation that claim 1 omits essential elements, as a preliminary matter, it is respectfully submitted that the Examiner's rejection is *per se* improper in that a § 112, second paragraph rejection is supposed to be based on an alleged failure to interrelate ***claimed*** elements. Here, the Examiner appears to allege that steps from the specification (details of the step, "developing the program on the development LSI device") are omitted altogether, rather than an interrelation between claimed steps. This reason alone renders the § 112, second paragraph rejection improper. Moreover, as noted in MPEP § 2172.01 cited by the Examiner, "it is not essential to a patentable combination that there be interdependency between the elements of the claimed device or that all the elements operate concurrently toward the desired result," and "[a] claim does not necessarily fail to comply with 35 U.S.C. 112, second paragraph where the various elements do not function simultaneously, are not directly functionally related, do not directly intercooperate, and/or serve independent purposes."

Moreover, the Examiner's allegation that the ***details*** of the step, "developing the program on the development LSI device," are essential and need to be recited in the claims is an improper attempt by the Examiner to limit the claims to a specific, preferred embodiment. The Examiner is directed to MPEP § 2164.08(c), which sets forth that "[l]imiting an applicant to the preferred [process] in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts." It is respectfully submitted that details of the respective features are simply exemplary/preferred embodiments. The ***particular process*** by which the program can be developed on the development LSI device is not essential for operation of the invention in its entire, broad scope.

In this case, the disclosed manner(s) by which the program can be developed on the development LSI device are simply exemplary/preferred embodiments, wherein "[f]eatures which are merely preferred are not to be considered critical," *In re Goffe*, 191 USPQ 429, 431 (CCPA 1976). In this regard, there can be several manners by which the program can be developed on the development LSI device (exemplary embodiment described in Applicants' specification); and absent prior art, Applicants are entitled to the full scope thereof. Accordingly, the claims need not recite the particular steps for the program developing step. Applicants' specification simply provides non-limiting exemplary embodiments of doing so. Indeed, as set forth in MPEP § 2173.04, claim breadth is not indefiniteness.

Based on all the foregoing, it is respectfully requested that the § 112, second paragraph rejection be withdrawn.

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Claims 1-8, 12 and 17 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kuroda et al. '779 ("Kuroda"), and claims 10, 13, 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuroda in view of Giles et al. '352. Claims 1, 8, 10 and 12 are independent. These rejections are respectfully traversed for the following reasons.

A. Claim 1

Claim 1 recites in pertinent part, "setting the ***provided*** LSI device to a development mode ... ." At least this feature of claim 1 is not disclosed by Kuroda. The Examiner alleges that Figure 16 (step S36) of Kuroda reads on this feature of the present invention. The Examiner's allegation is not understood. Indeed, Kuroda merely discloses data transfer between the electronic data storage apparatuses A, B (Fig.16). Specifically, Kuroda discloses that an authentication information MAC (Message Authentication Code) is generated in the electronic data storage apparatus A (step S36). It is then determined whether or not the MAC obtained is equal to the MAC computed using a master key in the electronic data storage apparatus B (steps S36-S43).

Indeed, it appears the Examiner's position may have been, at least in part, based on his interpretation set forth in the Office Action in relation to the § 112, second paragraph rejection regarding the reference to an LSI device having the same structure as that of the LSI device. Accordingly, it is respectfully submitted that the distinction over Kuroda has been clarified by the enclosed amendment in which a program can be developed using another LSI device different from the LSI device of the system in which the program is installed. Kuroda appears silent as to using another LSI device, let alone suggest setting the provided LSI device to a development mode as embodied by claim 1.

B. Claims 8 and 10

Claims 8 and 10 embody ***a development*** LSI device having the same structure as that of an LSI device on which the encrypted program runs. At least this feature of claims 8 and 10 is not disclosed by Kuroda. The Examiner alleges that col. 13, lines 40-43 of Kuroda read on this feature of the present invention. Similarly to claim 1, it appears the Examiner's position may have been, at least in part, based on his interpretation set forth in the Office Action in relation to the § 112, second paragraph rejection regarding the reference to an LSI device having the same structure as that of the LSI device. Kuroda appears silent as to using another LSI device, let alone suggest a development LSI device having the same structure as that of an LSI device on which the encrypted program runs as embodied by claims 8 and 10.

C. Claim 12

Claim 12 recites in pertinent part, "a first step of obtaining in the LSI device the raw common key from the common key information stored in the secure memory [and] a second step of decrypting in the LSI device a common key-encrypted program supplied from the external memory into a raw (binary) program using the raw common key obtained at the first step." At least this feature of claim 12 is not disclosed by Kuroda. Indeed, it is respectfully submitted that Kuroda is completely silent as to the aforementioned steps recited in claim 12. In fact, the Examiner appears to have overlooked these claimed steps as the Examiner does not address these limitations of claim 12 in the outstanding Office Action. In imposing a rejection under 35 U.S.C. §102, the Examiner is required to point to "page and line" wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

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As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that the cited prior art does not anticipate claims 1, 8, 10 and 12, nor any claim dependent thereon. The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

> To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claim 10 because the proposed combination fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 1, 8, 10 and 12 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 102/103 be withdrawn.

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CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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